



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

AF/2122

In re application of: **Browning et al.**

Serial No.: 09/620,714

Filed: July 20, 2000

For: **Method and Apparatus to Debug
a Program from a Predetermined
Starting Point**

35525

PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

§ Group Art Unit: 2122
§
§ Examiner: **Steelman, Mary J.**
§
§ Attorney Docket No.: **AUS9-2000-0277-US1**
§

Certificate of Mailing Under 37 C.F.R. § 1.8(a)

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Sir:
ENCLOSED HEREWITH:

- Request for Reinstatement of Appeal Under 37 C.F.R. 1.193(b)(2);
- Supplemental Appellant's Brief (in triplicate) (37 C.F.R. 1.192); and
- Our return postcard.

No fees are believed to be required. If, however, any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

Respectfully submitted,

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Group Art Unit: **2122**

Examiner: **Steelman, Mary J.**

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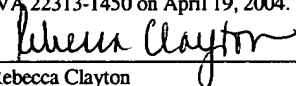
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**ATTENTION: Board of Patent
Appeals and Interferences**

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By:


Rebecca Clayton

REQUEST FOR REINSTATEMENT OF APPEAL UNDER 37 CFR 1.193(b)(2)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

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In response to the Office Action dated 03/09/2004, reinstatement of the appeal previously filed on 10/30/2003 is respectfully requested. A Supplemental Appeal Brief, which is duplicative of the Appeal Brief previously filed on 12/24/2003, is being filed concurrently herewith to comply with requirements of 37 C.F.R. 1.193(b)(2)(ii).

Reinstatement of the appeal is requested in that the Examiner has improperly re-opened prosecution of this case in the most recent Office Action dated 03/09/2004. Per 1208.01 (entitled "Prohibition Against Entry of New Ground of Rejection in Examiner's Answer"):

"37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. At the time of preparing the answer to an appeal brief, however, the examiner may decide that he or she should apply a new ground of rejection against some or all of the appealed claims. In such an instance where a new ground of rejection is necessary, the examiner should reopen prosecution. The examiner must obtain supervisory approval in order to reopen prosecution after an appeal. See **MPEP § 1002.02(d)**.

There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. *Id.* at 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under **35 U.S.C. 103** does not constitute a new ground of rejection)."

The thrust of the Examiner's rejection remains the same in this most recent Office Action, as the identical statutory basis is used in rejecting the identical claims as was used in the Final Office Action dated 07/30/2003. Thus, there is no new ground of rejection and hence no valid basis for the Examiner to re-open prosecution for this case.

Accordingly, Applicants hereby request re-instatement of the Appeal to the Board of Patent Appeals and Interferences previously filed on 10/30/2003.

Respectfully submitted,

DATE: _____

4/19/04



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